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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,532	10/12/2006	Marie-Claire Grosjean-Cournoyer	P/3610-74	9561

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EXAMINER	
PIHONAK, SARAH	
ART UNIT	PAPER NUMBER
4121	
MAIL DATE	DELIVERY MODE
03/06/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,532	GROSJEAN-COURNOYER ET AL.	
	Examiner	Art Unit	
	SARAH PIHONAK	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/7/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This application is a 371 (national stage application) of PCT/EP05/02566, and claims foreign priority to Application No. 04356017.6, filed 2/12/04. This application also claims priority to Provisional Application No. 60/636898, filed on 12/17/04.

1. Claims 1-18 are pending.

2. Claim 18 is withdrawn from consideration.

3. Applicant's election of the invention of Group I, claims 1-17, in the reply filed on 2/6/09 is acknowledged. Additionally, upon the requirement for the species election, Applicants elected the compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 3 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, or species there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/6/09.

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. This application claims priority to Application No. 04356017.6. The instant claims are therefore given the priority date of 2/12/04.

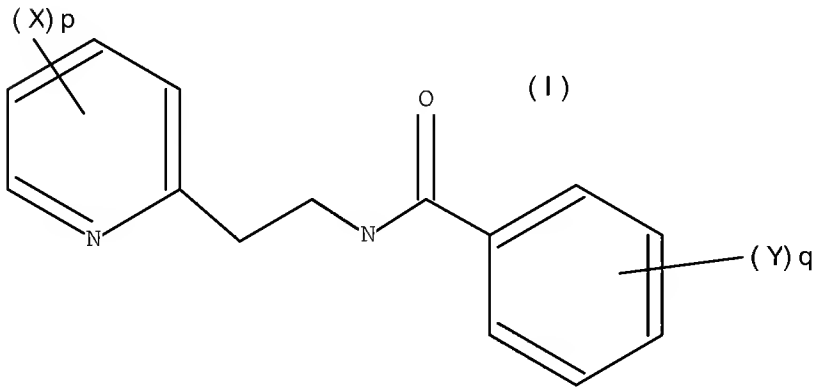
35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-2, and 4-17 are rejected under 103(a) as being unpatentable over WO 2001/11965, in view of WO 2002/069712, and further in view of Colby, *Weeds*, **15**, pp. 20-22, 1967. The '965 publication and the Colby reference were provided by the Applicants in the Information Disclosure Statement.

8. Instant claim 1 cites a composition comprised of a compound of general formula (I), and additionally, a compound capable of inhibiting fungal spore germination or mycelium growth. The claim also cites that compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2- trifluoromethylbenzamide and the second compound are present in a weight ratio from 0.01 to 20.



The '965 publication teaches, (p. 49, claim 1), the use of N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide as a phytopathogenic fungicide. The '965 publication also teaches that the compound may be combined with other fungicidal compounds (p. 10, paragraph [0041], lines 4-8), but does not cite specific agents.

9. Instant claim 2 cites the composition as stated in instant claim 1, and additionally, that the subscript p of formula (I) is equal to 2. The compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is a species of this formula, and this is therefore taught by the '965 publication (p.49, claim 1).

10. Instant claim 4 cites the composition as stated in instant claim 1, and also, that the X substituent of formula (I) is chosen as being either halogen or haloalkyl. The compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2-trifluoromethylbenzamide is a species of this formula, and is therefore taught by the '965 publication (p.49, claim 1).

11. Instant claim 5 cites the composition as stated in instant claim 1, and also, that the X substituent of formula (I) is either a chlorine atom or a trifluoromethyl group. The compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2-trifluoromethylbenzamide is a species of this formula, and is therefore taught by the '965 publication (p. 49, claim 1).

12. Instant claim 6 cites the composition as stated in instant claim 1, and also, that the Y substituent is either halogen or haloalkyl. The compound N-{2-[3-chloro-5-

(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is a species of this formula, and is therefore taught by the '965 publication (p. 49, claim 1).

13. Instant claim 7 cites the composition as stated in instant claim 1, and also, that the Y substituent is either chlorine or a trifluoromethyl group. The compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is a species of this formula, and is therefore taught by the '965 publication (p. 49, claim 1).

14. Instant claim 8 cites that the compound of formula (I) is selected from 3 different compounds, which includes the elected species N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide. This is taught by the '965 publication (p.49, claim 1).

15. Instant claim 9 cites the composition of instant claim 8, specifically, that the selected compound of formula (I) is N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide. This compound is taught by the '965 publication (p. 49, claim 1).

16. Instant claim 15 cites the composition as stated in instant claim 1, and also, that a compound (c) is present. The '965 publication teaches that the fungicidal composition "can comprise one or more additional active ingredients, for example compounds known to possess plant-growth regulant, herbicidal, fungicidal...", (p. 10, lines 4-6).

17. Instant claim 17 cites the composition as stated in instant claim 1, and also, that an agriculturally acceptable support, carrier, filler, and/or surfactant is present. The '965 publication also teaches that the composition may be comprised with an agriculturally acceptable diluent or carrier (p. 8, lines 28-30), and surfactant (p. 10, paragraph [0042]).

18. Regarding instant claim 1, the '965 publication does not specifically teach that the N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide compound is combined with the additional agent in a weight ratio range from 0.01 to 20. While the '965 publication teaches that the elected species can be combined with a variety of other anti-fungal agents (p. 10, paragraph [0041]), it does not specifically teach which particular agents can be included in the composition.

19. Regarding instant claim 10, the '965 publication does not teach specifically that N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide can be combined with a dicarboxamide derivative in a fungicidal composition.

20. Regarding instant claim 11, the '965 publication does not specifically teach that the dicarboxamide derivative in the composition is chlozolinate, iprodione, procymidone, or vinclozolin.

21. Regarding instant claim 12, the '965 publication does not specifically teach that N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide can be combined with a phthlalimide derivative.

22. Regarding instant claim 13, the '965 publication does not specifically teach that N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide can be combined with a phthalamide derivative such as captan.

23. Regarding instant claim 14, the '965 publication does not specifically teach that N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide can be combined with a compound capable of inhibiting fungal spore germination or mycelium growth, such as cymoxanil.

24. Regarding instant claim 16, the '965 publication does not specifically teach that an additional compound (c) is selected from diethofencarb, hexaconazole, cyprodinil, tebuconazole, or bromuconazole.

25. Regarding instant claim 1, the '712 publication teaches that a pyridinylbenzamide fungicide with a chemical structure very similar to the elected species, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, can be combined with additional anti-fungal agents (p. 3, p. 10-11). The '712 publication teaches that one of the additional anti-fungal agents has a mode of action in which it inhibits complex III of cellular respiration (p. 36, claim 1), but may also be combined with an additional list of agents (p. 3, p. 10-11), that possess a variety of modes of fungicidal activity. Some of the listed compounds specifically are known in the art to inhibit spore germination or mycelium growth, such as iprodione (p. 11, line 1). Therefore, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with a compound known to inhibit fungal spore germination or mycelium growth.

26. Regarding instant claim 10, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with iprodione (p. 11, line 1). Iprodione is a dicarboxamide derivative, and therefore the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with a dicarboxamide derivative.

27. Regarding instant claim 11, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with iprodione (p. 11, line 1).

28. Regarding instant claim 12, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with captan (p. 10, lines 3-16). As

captan is a phthlalimide derivative, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with a phthalimide derivative.

29. Regarding instant claim 13, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with captan (p. 10, lines 3-16).

30. Regarding instant claim 14, the '712 publication teaches that a pyridinylbenzamide fungicide can be combined with one of the compounds listed in instant claim 14, such as cymoxanil (p. 10, lines 3-19).

31. Regarding instant claim 16, the '712 publication teaches that a pyridinylbenzamide compound can be combined with an additional compound such as diethofencarb (p. 10, lines 9-20).

32. Regarding instant claim 1, the '712 publication does not teach that the pyridinylbenzamide compound can be combined with an additional compound (b) in a weight ratio from 0.01 to 20.

33. Colby teaches a method for calculation of synergistic responses for herbicidal compositions comprised of different compounds (p. 20, formula IV). According to this method, the percent inhibition of growth by each herbicide component in the composition can be determined, as well as the combined synergistic effect. The amount of each component used to give the best synergistic effect can also be determined. It is obvious that the optimal ratio of components can be deduced from the fomula for calculating the synergistic effect, from which one would arrive at the weight ratio of the N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide compound and the additional fungicide from 0.01 to 20.

34. The '965 publication teaches that the N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide compound can be combined with additional active fungicidal agents, comprising agriculturally acceptable diluents or carrier, or surfactants. While the '965 publication does not specifically teach which additional anti-fungal agents may be combined with N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide , the '712 publication teaches that structurally similar pyridinylbenzamide compounds can be combined with other agents known in the art to inhibit fungal spore germination or mycelium growth (p. 10, lines 9-28). It is known in the art that it is beneficial to have fungicidal compositions comprised of agents with different modes of action, to lower the possibility of fungal resistance. Colby teaches a method for calculating the synergistic effect of herbicidal compositions, from which the optimal ratio for each component can be determined. From the teachings of Colby, one could derive at the optimal ratio of N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide to the additional fungicidal agents, to achieve the highest synergistic effect.

35. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the '965 publication, the '712 publication and Colby to arrive at a fungicidal composition with a wider mode of activity, with reduced possibility of resistance.

36. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

37. Claims 1-2, 4-9, and 16-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-9, and 18-19 of U.S. Patent No. 10/587802 in view of Leroux, *Pest. Sci.*, **47**, 191-197, 1996.

38. Instant claim 1 cites a composition comprised of the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, and an additional compound (b), which is capable of inhibiting spore germination or mycelium growth in fungal organisms. Instant claim 1 also cites that the elected compound and (b) are combined in a weight ratio from 0.01 to 20. Claim 1 of Application No. 10/587802 also cites a fungicidal composition that is comprised of the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, and an additional compound (b), which is capable of inhibiting electron transport in fungal organisms. Claim 1 of Application No. 10/587802 also cites that the elected compound is combined with compound (b) in a weight ratio from 0.01 to 20. While compound (b) of the instant application and Application No. 10/587802 appear to have a different mode of action, both applications include the term 'comprising'. For example, claim 18 of Application No. 10/587802 cites that the compound captan may be present in the fungicidal composition. It is known in the art that captan has a broader spectrum of anti-fungal activity that includes inhibiting spore germination, as well as inhibiting cellular respiration, as taught by Leroux (p. 191, right column, paragraph 2). Therefore, claims 1 and 18 of Application No. 10/587802 describe a fungicidal composition which has all of the elements of instant claim 1.

39. Instant claim 2 cites a composition comprised of a compound of general formula (I), and that the subscript p is equal to 2. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, is a species of this formula. This is identical to what is cited for claim 2 in Application No. 10/587802.

40. Instant claim 4 cites the composition comprised of a compound of general formula (I), and that the substituent X is either halogen or haloalkyl. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is identical to what is cited in claim 4 of Application No. 10/587802.

41. Instant claim 5 cites the composition as stated in instant claim 1, and that the X substituent is either chlorine or a trifluoromethyl group. The elected species N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is included in this claim. This is also what is disclosed in claim 5 of Application No. 10/587802.

42. Instant claim 6 cites the composition as stated in instant claim 1, and also, that the Y substituent is either halogen or haloalkyl. The elected compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is a species of this formula. This is also what is disclosed in claim 6 of Application No. 10/587802.

43. Instant claim 7 cites the composition as stated in instant claim 1, and also, that the Y substituent is selected as being a chlorine atom or a trifluoromethyl group. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2-trifluoromethylbenzamide is a species of this formula. This is also what is disclosed in claim 7 of Application No. 10/587802.

44. Instant claim 8 cites the composition as stated in instant claim 1, and further lists 3 compounds which may be selected for general formula (I). The elected compound N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide is a

species of this formula. This is also what is disclosed in claim 8 of Application No. 10/587802.

45. Instant claim 9 cites the composition as stated in instant claim 8, and also, that the compound selected from general formula (I) is the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide. This is identical to what is disclosed in claim 9 of Application No. 10/587802.

46. Instant claim 16 cites that a fungicidal compound (c) may be present, and lists several compounds, one of which is tebuconazole. This compound is also listed as a composition component in claim 18 of Application No. 10/587802.

47. Instant claim 17 cites the composition as stated in instant claim 1, and that the composition may be further comprised of an agriculturally acceptable support, carrier, filler, and/or surfactant. This is identical to what is cited in claim 19 of Application No. 10/587802.

48. The information disclosure statement (IDS) submitted on 8/7/06 was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-Thursday 7:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

/Patrick J. Nolan/
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